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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,368	04/12/2004	Steven A. Bogen	1159.1004-006	4846

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EXAMINER	
ALEXANDER, LYLE	

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
01/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,368	BOGEN ET AL.	
	Examiner	Art Unit	
	Lyle A. Alexander	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/31/07;11/5/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3,5-8,10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) or Rogers et al. (USP 4,043,292) in view of Potter et al. (USP 5,819,842).

See the appropriate paragraphs of the 11/2/06 Office actions.

The 11/5/07 amendments have added new claims 15-18. These claims require the supporting platform to be movable or a carousel. All of the references Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) and Rogers et al. (USP 4,043,292) teach the slide on a movable carousel and have been properly read on the instant claims.

Response to Arguments

Applicant's arguments filed 11/5/07 have been fully considered but they are not persuasive.

Applicants' state Potter fails to teach an apparatus for the analysis of biological samples in a well and not on a slide as presently claimed. The instant language "slide" is sufficiently broad to be properly read on any structure that supports a biological sample, such as the taught well.

Applicants' state one having ordinary skill in the art would not have looked to Heidt and Kerr as pertaining to the field of microscope slide staining. These remarks are not commensurate in scope because the pending claims that are directed to a dispensing assembly and a method for processing biological samples.

Applicants' state none of the cited prior art references teach the conductive heating of each microscope slide. These remarks are not commensurate in scope because the pending claims are only directed to "heating" and do not specify conductive heating. Even if such amendments were made, the Office would take the position that one having ordinary skill in the art would have expected the same results of heating from the taught "convective" heating as compared to "conductive heating".

Applicants' state the 35 USC 103 rejections of Heidt et al (USP 5,089,229), Copland et al. (USP 5,654,200), Kerr et al. (USP 5,075,079) or Rogers et al. (USP 4,043,292) in view of Potter et al. are untenable because Potter does not relate to the same field of endeavor. The MPEP provides guidance in section 2141.01 as to what is considered analogous art. The court decided Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858,26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng 'g Corp. v.Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir.2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The instant facts are the primary references are directed to the automated processing of slides encompassing all of the claimed elements except for an individual

sensor beneath each slide to control each slides temperature independently. The Office consulted Potter who also teaches an apparatus for manipulation of biological samples on slides. Potter teaches an individual sensor below each slide that regulates the temperature of each individual slide. This is advantageous to gain the advantage of tailoring a precise temperature for an individual sample. The Office maintains the primary references and Potter are both concerned with the same problem—heating and manipulating biological samples. The Office maintains Potter is analogous art and the rejections of record are proper.

Applicants' argue Potter does not teach tissue staining, mentions slides, histochemistry or tissue samples. Again, these remarks are not commensurate in scope because the pending claims that are directed to a dispensing assembly and a method for processing biological samples which is clear taught by Potter. Additionally, the instant claim language of "slide" is sufficiently broad to be read on Potter.

Applicants' state one having ordinary skill in the art did not believe that special staining techniques could be automated. Again, these remarks are not commensurate in scope because the pending claims that are directed to a dispensing assembly and a method for processing biological samples. Even if these remarks were commensurate in scope, in the absence of more definitive evidence, the Office does not find Applicants' statements convincing.

The publications "AX,AY,AZ,AR2" have not been considered because they are not prior art. It is not clear in what context Applicants' want these publications considered.

The Declaration under 37 CFR 1.132 filed 11/5/07 is insufficient to overcome the rejection of claims 1-18 based upon as set forth in the last Office action because:

A declaration or affidavit is, itself, evidence that must be considered. The weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) ("expert's opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement"). The 11/5/07 1.132 Declaration put forth the opinion of Dr. Ron Zeheb and is not backed by factual evidence and is not convincing.

This is a RCE of applicant's earlier Application No. 10/823,368. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
Art Unit 1743